

Appln. No. 10/826,722
Amendment dated August 20, 2008
Reply to Office Action mailed June 19, 2008

REMARKS

Reconsideration is respectfully requested.

Entry of the above amendments is courteously requested in order to place all claims in this application in allowable condition and/or to place the non-allowed claims in better condition for consideration on appeal.

Claims 1, 3 and 10 through 16 remain in this application. Claims 2 and 4 though 9 have been cancelled. No claims have been withdrawn. No claims have been added.

Paragraphs 8 through 18 of the Office Action

Claims 10 through 14 have been rejected under 35 U.S.C. §102(b) as being anticipated by Garrett.

Claims 1, 3, 15 and 16 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Garrett in view of Jacobi.

Claim 10 requires in part "presenting an offer to the user based upon the information in the user profile regarding the subject of computerized transactions by the user that is intended for use by the user".

In the rejection of claim 10, it is alleged that (*italics emphasis in original, underline emphasis added*)

Garrett, as shown, discloses the following limitations:

- *presenting an offer to the user based upon the information in the user profile regarding the subject of computerized transactions by the user that is intended for use by the user* (see at least column 7, lines 39-40 shopping list, see also Figure 5, there is no guidance in the specification defining the contents of a user profile, examiner interprets the user profile to be a aggregation of previous purchases designated to the user not to third party recipients, further examiner broadly interprets any listing or products to constitute an offer,

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therefore a list of products organized under products purchased or to be purchased by/for the user anticipates the limitation).

However, it is submitted that there is no reasonable basis for interpreting the claim requirement of "an offer" as including previously purchased products as asserted in the rejection. Section 2111 of the MPEP states that (underline emphasis added):

During patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification." *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).

It is submitted that the meaning that is sought to be assigned to "offer" in the rejection is not consistent with the specification, and the definition of "offer" therein. Further, §2111 of the MPEP states that (underline emphasis added)

While the claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims, this is not the mode of claim interpretation to be applied during examination. During examination, the claims must be interpreted as broadly as their terms reasonably allow. *In re American Academy of Science Tech Center*, ___ F.3d ___, 2004 WL 1067528 (Fed. Cir. May 13, 2004)(The USPTO uses a different standard for construing claims than that used by district courts; during examination the USPTO must give claims their broadest reasonable interpretation.). This means that the words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification.

Thus, in the event that the Examiner does not believe that the term "offer" is not provided a clear definition in the specification, the interpretation of "offer" still must be the "plain meaning" of the term.

The MPEP §2111 further states that:

Claim terms are presumed to have the ordinary and customary meanings attributed to them by those of ordinary skill in the art. *Sunracer Roots Enter. Co. v. SRAM Corp.*, 336 F.3d 1298, 1302, 67 USPQ2d 1438, 1441 (Fed. Cir. 2003); *Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1298 67 USPQ2d 1132, 1136 (Fed. Cir. 2003)("In the absence of an express intent to impart a novel meaning to the claim terms, the words are presumed to take on the

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ordinary and customary meanings attributed to them by those of ordinary skill in the art."). It is the use of the words in the context of the written description and customarily by those skilled in the relevant art that accurately reflects both the "ordinary" and the "customary" meaning of the terms in the claims. *Ferguson Beauregard/Logic Controls v. Mega Systems*, 350 F.3d 1327, 1338, 69 USPQ2d 1001, 1009 (Fed. Cir. 2003)

It is submitted that the interpretation of "offer" as being "any listing or products", particularly previously purchased by a user or products already selected by the user for purchase, is not an interpretation that would be recognized by one of ordinary skill in the art as being the "ordinary and customary meaning" of the term "offer".

Also, Figure 5 of the Garrett patent is described by Garrett as showing "a view of the details of selections/purchases for a given party", and one of ordinary skill in the art would not interpret the depiction of previously purchased items as an "offer" as one of ordinary skill in the art would understand that term.

Further, the line of argument made in the rejection does not make sense in that the claim requires "'presenting an offer to the user based upon the information in the user profile regarding the subject of computerized transactions by the user that is intended for use by the user". If the rejection is based upon the interpretation that an offer is simply a "list of products organized under products purchased or to be purchased by/for the user" in the user profile, and the claim requires that the offer be "based upon the information in the user profile", then the rejection implies that the offer includes the same information upon which the offer is based. In other words, the interpretation in the rejection alleges that the offer ("a list of products organized under products purchased or to be purchased by/for the user") is based upon the information in the user profile ("the user profile [having an] aggregation of previous purchases". This interpretation is submitted not to make sense to one of ordinary skill in the art.

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As the Response to Arguments section of the Office Action does not directly address any of the arguments made in the previous response, these remarks will turn first to the revised rejection based upon the allegedly obvious combination of Garrett and Jacobs upon which the rejection of claims 1, 3, 15, and 16 is based. In that rejection, it is alleged that (*italics emphasis in original, underline emphasis added*):

Garrett, as shown, discloses the following limitations:

- *presenting, by the computerized transaction system, a product offering tailored to one or more of the user and the third party using the aggregated information associated with the transaction.*

Initially, it is noted that this requirement does not appear anywhere in the language of claim 1, and it is therefore submitted that it is immaterial to the patentability of claim 1 that Garrett might disclose this subject matter (although the rejection does not cite any portion of the Garrett patent to support this allegation of disclosure by Garrett and the point is not conceded).

The rejection further contends that (*italics emphasis in original, underline emphasis added*):

Regarding the following limitation, Garret discloses presenting past and present product selections organized by recipient (see at least column 7, lines 39-40 shopping list, see also Figure 5) which reads on *presenting a product offering tailored to one or more of the user and the third party using the aggregated information associated with the transaction when product offering is broadly construed to include a list of products.*

However, as was noted above, this portion of the rejection appears to be addressing language that does not appear in the claim, and thus it is not entirely clear that this statement is addressing the claim being considered. It is further submitted that "broadly construing" the term "product offering" is irrelevant to the patentability of claim 1, as it is not a requirement of the claim. The rejection appears to be directed at establishing that a "product

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offering" would be considered by one of ordinary skill in the art to include a shopping list of the user, but the claim does not require a "product listing", it is submitted that there is no significance to this point, even if correct.

The rejection then concedes that "Garrett does not specifically disclose the following additional limitations", but further alleges that the Jacobi patent discloses:

- presenting, by the computerized transaction system, one or more of a special offer, a promotion, a product recommendation, and a product suggestion tailored to one or more of the user and the third party using the aggregated information associated with the transaction (see at least column 4, lines 55-61, implementing a variety of recommendation services... generates personal recommendations),

It is then alleged in the rejection that:

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine capacity to differentiate between purchase histories and item selections for various parties within one user's account (the invention of Garrett) with the automated generation of product promotions/recommendations based on shopping cart content and previous purchases (the invention of Jacobi) since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

However, it is submitted that the alleged equivalence of a requirement that does not appear in the claim to a shopping list in the Garrett patent, which is admitted to not disclose any capability to "present[], by the computerized transaction system, one or more of a special offer, a promotion, a product recommendation, and a product suggestion tailored to one or more of the user and the third party using the aggregated information associated with the transaction" as required by the claim, does not present the basis for an obviousness rejection.

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It is therefore submitted that the cited patents, and especially the allegedly obvious combination of Garrett and Jacobi set forth in the rejection of the Office Action, would not lead one skilled in the art to the applicant's invention as required by claims 1 and 15. Further, claim 3, which depends from claim 1 and claim 16, which depends from claim 15 also include the requirements discussed above and therefore are also submitted to be in condition for allowance.

Withdrawal of the 102(b) and §103(a) rejections of claims 1, 3 and 10 through 16 is therefore respectfully requested.

CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

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